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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,412	09/13/2004	Tsugio Wakita	28951.5341	6883
53067 7590 06/05/2007 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVE., NW WASHINGTON, DC 20036			EXAMINER PUNNOOSE, ROY M	
			ART UNIT 2886	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/507,412

Applicant(s)

WAKITA ET AL.

Examiner

Roy M. Punnoose

Art Unit

2886

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/07; 5/06; 9/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Restriction Requirement*

1. Applicant's election with traverse of claims 1, 7 –8 (Group I) in the reply filed on 02/20/2007 is acknowledged. Claims 2-6 have been withdrawn from consideration. The traversal is on the ground(s) that the examination of the entire application can be made without serious burden. Applicant asserts that the search and examination of an entire application can be made without serious burden, and therefore the examiner must examine it on the merits. Examiner respectfully disagrees. Applicant's argument is not found persuasive for the following reasons.

The full guidelines stated in the MPEP regarding search burden are set forth at 803, where the MPEP states: "For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02. At 808.02.(C), the MPEP states: "A different field of search: where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g. searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field' of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search."

As discussed in the restriction requirement, the application indeed contains more than one invention employing different fields of search and separate classifications.

Moreover, the issue of burden merely plays a minor role for the basis to support the restriction requirement. Since it has been concluded that the pending application includes more than one separate distinctive and independent invention, the restriction is therefore proper. In particular, it appears that applicant believes the issue of burden only arises from the search of prior art and examination of the application in determining the patentability of the claimed invention. However, applicant is respectfully reminded that conducting a search on application merely plays a small part of examining the invention. Burden may also arise from prosecuting multiple inventions in a single application. Such a type of prosecution merely leads to complication in patentability determination that may ultimately sacrifice the quality of patentability determination. In view of this reason, a restriction imposed is clearly proper.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al (US\_5,922,617).

4. Claims 1 and 7 are rejected because:

A. Wang et al (Wang hereinafter) teaches of an analysis apparatus (see Figures 6, 7 and 8) for irradiating detection light on an analysis disc 80 having an analysis object disposed on a part thereof, and reading a state of the analysis object,

wherein the analysis disc 80 having a mark 86 is set in the apparatus, the mark 86 being recorded over a radial direction of a reading area at least in one of frontward and rearward positions of the reading area in a rotation direction, the reading area being disposed with the analysis object, and the analysis apparatus comprises: a pickup for detecting the mark and detection light from the analysis object disposed on the set analysis disc, and an image processor for performing video acquisition or shape count on the analysis object by performing video processing for aligning the analysis object and a reading signal of the mark by a time axis relative to a position of the mark, the analysis object and the reading signal of the mark being read in time series by the pickup that traces a track (see col.14, line 60 – col.16, line 5; col.17, lines 24-55) for characterizing a sample material on the disc/sample holder.

- B. Wang does not teach explicitly of teach of video acquisition or shape count on the analysis object for characterizing a sample material on the disc/sample holder.
- C. However, Wang teaches of the use of a computer for monitoring the sample and using appropriate software to determine a variety of information, including site geometry (see col.17, lines 24-55) for characterizing a sample material on the disc/sample holder.
- D. In view of Wang's teaching, it would have been obvious to one of ordinary skill in the art to use an image processing software in Wang's apparatus for the purpose of characterizing a sample material on the disc/sample holder.

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***Contact/Status Information***

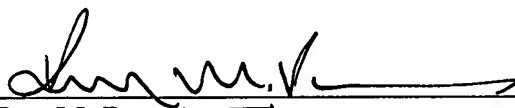
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**.

The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Tarifur Chowdhury** can be reached on **571-272-2287**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 29, 2007

  
**Roy M. Punnoose**  
Patent Examiner  
Art Unit 2886